



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,831	07/11/2001	Thomas J. Maginot	22220-06167	1578

758            7590            09/10/2002

FENWICK & WEST LLP  
TWO PALO ALTO SQUARE  
PALO ALTO, CA 94306

EXAMINER
----------

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
----------	--------------

3738

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/903,831	MAGINOT, THOMAS J.	
<b>Period for Reply</b>	Examiner	Art Unit	
	Paul B. Prebilic	3738	
<b>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</b>			
<b>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</b>			
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>			
<b>Status</b>			
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>05 August 2002</u> .			
2a) <input type="checkbox"/> This action is FINAL.                    2b) <input checked="" type="checkbox"/> This action is non-final.			
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.			
<b>Disposition of Claims</b>			
4) <input checked="" type="checkbox"/> Claim(s) <u>47-66</u> is/are pending in the application.			
4a) Of the above claim(s) _____ is/are withdrawn from consideration.			
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.			
6) <input checked="" type="checkbox"/> Claim(s) <u>47-66</u> is/are rejected.			
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.			
8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.			
<b>Application Papers</b>			
9) <input checked="" type="checkbox"/> The specification is objected to by the Examiner.			
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).			
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.			
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.			
<b>Priority under 35 U.S.C. §§ 119 and 120</b>			
13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).			
a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.			
14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.			
15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.			
<b>Attachment(s)</b>			
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)		4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____	
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)	
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5,6,7</u> .		6) <input type="checkbox"/> Other: _____	

***Specification***

The disclosure is objected to because of the following informalities:

On page 1 of the specification, the continuing data needs to be updated with the current status of the grandparent application and the term "co-pending" should be deleted where it is no longer applicable.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49, 50, 54, 55, 60, 61, and 63-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Upon review of the claims and specification, it was determined that the use of "endoscope" was proper even though it is not explicitly used in the specification. Since a laparoscope (which is used in the specification) is a type of endoscope, it is acceptable to use "endoscope" in the claims since this is merely a broader way of stating laparoscope.

In claim 49, line 2, claim 54, line 2, claim 59, line 2 and claim 60, line 4, the use of the term "comprising" is confusing because the base claim has already set forth "the method comprising." Therefore, the Examiner suggests changing "comprising" to --- further comprising--- in order to overcome this objection and to make it clear that these

Art Unit: 3738

are additional limitations. Claims 50, 55, 60 and 61 are also indefinite because they depend upon the claims which contain the indefinite term "comprising."

With regard to claim 61, line 3, "instrument" should be rewritten as --endoscope-- because intervening claim 59 modified "instrument" to "endoscope."

With regard to claim 63, line 3, the semicolon makes the claim language unclear because the language "second end and lumen" follows it. Instead, the Examiner suggests inserting a comma in place of the semicolon in order to overcome this objection. Claims 64-66 are rejected because they depend upon indefinite claim 63.

With regard to claim 63, line 10, "final artery" lacks antecedent basis. Instead, "first artery" appears proper.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 57-55 and 57-62 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 14, 19, 33, and 47-53 of copending Application No. 09/475,789. Although the conflicting

Art Unit: 3738

claims are not identical, they are not patentably distinct from each other because the present claims are broader as to the details of the method manipulations but do not define the medical instrument as an endoscope. However, since the endoscope as claimed is for examination and surgery of an internal site of a patient, the present claims are clearly obvious in view thereof. Furthermore, the present claims are obvious over the copending claims because they are read on thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 47-60 and 62-66 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. 5,211,683. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are read on by the copending claims such that they are clearly obvious in view thereof.

Claims 47-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5,749,375. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are read on by the copending claims such that they are clearly obvious in view thereof.

Claims 47-60 and 62-66 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,304,220. Although the conflicting claims are not identical, they are not

Art Unit: 3738

patentably distinct from each other because the present claims are read on by the copending claims such that they are clearly obvious in view thereof.

Claims 47-60 and 62-66 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 5,571,167. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are read on by the copending claims such that they are clearly obvious in view thereof.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 47, 51, and 62 are rejected under 35 U.S.C. 102(b) as being anticipated by Kensey (US 4,890,612) where the catheter or sheath (26) is the blood-conveying conduit because it would be capable of conveying blood being a tube. The instrument that creates the opening in the blood vessel at the selected site is the needle within the cannula of Kensey. The anastomosis is formed by the sheath (26); see Figure 1 and column 3, line 25 to column 4, line 2.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 3738

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 48, 52, 53, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kensey (US 4,890,612) alone. Kensey meets the claim language as set forth above, but fails to disclose puncturing an aorta as claimed. However, since Kensey sets forth that any artery is suitable (the femoral artery is merely an example), it would have been prima fascia obvious to use the Kensey method on an aorta since it is an artery also. Applicants have not disclosed that use on an aorta provides some advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Kensey's invention to perform equally well on the aorta because it is a type of artery. Therefore, it would have been an obvious matter of design choice to modify Kensey to obtain the invention as specified in the claims.

### **Conclusion**

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

Art Unit: 3738

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic  
Primary Examiner  
Art Unit 3738